

REMARKS

All pending claims in the present application have been finally rejected in the Office Action of October 11, 2005 (the Office Action). All claims have been rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Gudjonsson et al., U.S. Patent 6,564,261 (Gudjonsson) and Tang et al., U.S. Patent 5,793,365 (Tang). For the reasons specified herein and below, applicant respectfully traverses the rejections, requests reconsideration of the claims, and timely allowance of this application.

Rejections from the Office Action of 10/11/2005 - 35 USC §103

Claims 1-54 were rejected in the Office Action. Prior to addressing the rejections, a short summary of the present invention is provided to assist with an understanding of the distinctions found in the claims.

The present invention is a "system and method for combining the convenience of instant messaging with video conferencing capability to allow a user to initiate a video conference using [instant messaging]." (Summary of the Invention, page 2, lines 6-7.) Most simply stated, in the context in which two or more users of an instant messaging (IM) system decide, during the exchange of instant messages, to initiate a video conference a special instant message may be sent causing the IM server managing their communications to communicate with a video conference server to initiate the video conference. While exceptionally convenient for the participants, generally, this is not a trivial exercise for the underlying systems to implement. For example, the system must maintain knowledge about the participants, such as contact data, preferred communication modes, protocols, and networks, and effectively communicate such

information to a video conference server, adapted to receive same from another server, together with appropriate instructions to cause the video conference server to properly allocate resources to support the video conference. The system effectively removes the requirement that a user visit a dedicated website to initiate or participate in a video conference, instead allowing a user to initiate a video conference directly while using one of a number of popular IM services.

In the language of claim 1, for example, "said video conference resource allocator adapted to allocate video conference resources in said second server in response to a request for a video conference from said instant messaging server (claim 1, lines 9-11, emphasis added)" reflects the ability to initiate a video conference from within an IM service. (See also claim 28, lines 10-12.) As recited in the specification, page 6, lines 12-15, "[w]hen an instant message setting up a video conference is sent by a client 12 via its IM client module 16, the video conference module 18 detects the message. It extracts information from the message which is used to set up the video conference automatically through the CTM server 20."

With this refresher concerning the present invention, we now turn to the rejections themselves. Claims 1-6, 9-14, 17-24, 27-33, 36-41, 44-51, and 54 were rejected in the Office Action under 35 USC §103(a) as being unpatentable over Gudjonsson in view of Tang. Applicant respectfully traverses the rejection of these claims. Neither reference discloses, teaches or suggests a method of establishing a video conference in response to a request for same by an instant messaging server, nor any suggestion for how the teachings of the two references may be combined to obtain such a limitation.

Gudjonsson teaches a network management system capable of securely establishing communication sessions between users. These sessions are of an arbitrary type, for example text-to-text, voice-to-voice, etc., established by the communications between servers. When a user wishes to initiate a communication session with a second user, he sends an invitation, and the system determines if the second user is available, the address of the second user, and the protocol required to include the second user.

Importantly, Gudjonsson does not disclose an IM server configured to initiate a video conference in response to an instant message communication sent by a user. Contrary to the assertion in the Office Action, the reference does not teach "a video conference resource allocator adapted to allocate video conference resources ... in response to a request for a video conference from said instant messaging server." There is no mention in Gudjonsson of using a message from one type of server to initiate a service on another type of server, let alone a specific mention of using an instant message to initiate a video conference. The cited section of Gudjonsson (col. 7, lines 42-51) merely states that an operator of a network can enable the network users to initiate various types of communications and appropriately charge for those services.

Tang teaches a user interface for collaborative work which provides users with a "chat room" feature. The chat room allows multiple users to communicate with each other via a central server and user interface. All users logged into the chat room see a common interface, and all communications are broadcast to all logged on users. While there is a disagreement among those skilled in the art about the relationship between instant messaging and chat rooms (see [http://en.wikipedia.org/wiki/Chat room](http://en.wikipedia.org/wiki/Chat_room)), the reference

makes no mention of instant messaging, nor the ability to launch any service, particularly a video conference, using a communication uniquely within a chat room.

Thus, the Gudjonsson and Tang references are silent as to the feature of initiating one type of communication service (i.e., a video conference) using a message from a different type of service (i.e., instant messaging). Furthermore, neither reference provides any motivation or teaching to combine one with the other or modify their disclosures to obtain such a feature. Technically, the references simply fail to disclose or suggest the feature of initiating a video conference in response to an instant message, as claimed in claims 1 and 28.

In establishing a case of *prima facie* obviousness, the cited references (or art in general) must specifically disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992)." M.P.E.P. § 2143.01 (emphasis added). It is not enough to show that there is some abstract motivation for combining references. Rather, a person of ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and

with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed.*" In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)(emphasis added). Accordingly, for both technical and legal reasons, the combination of Gudjonsson and Tang fail to render obvious the invention claimed in claims 1 and 28.

Moreover, the burden is on the Examiner in the first instance to explain how the prior art suggests and motivates the proposed combination so as to render obvious the claimed invention. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). The Office Action points to no motivation to modify or combine the references. The burden imposed by Ex parte Levy has not been met by the statements that "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gudjonsson to explicitly use a chat server as taught by Tang in order to provide text communications between two users" and "One [of] ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Gudjonsson and Tang to provide a system for a user to communicate with text, video, and audio." Such statements are, in the words of the Board of Patent Appeals, "a conclusion, rather than a reason." Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986). For at least this additional reason, the rejection of claims 1 and 28 is legally insufficient and should be reconsidered and withdrawn.

Furthermore, claims 2-6, 9-14, 17-24, and 27 depend directly or indirectly from claim 1, and claims 29-33, 36-41, 44-51, and 54 depend directly or indirectly from claim 28, and therefore contain all of the limitations found in claims 1 and 28, respectively. Thus, those claims are patentably distinct from the cited references for at least the

reasons enumerated above with regard to claims 1 and 28. Accordingly, applicant respectfully traverses the rejections of claims 1-6, 9-14, 17-24, 27-33, 36-41, 44-51, and 54, and requests their reconsideration and allowance.

Claims 7, 8, 15, 16, 25, 26, 34, 35, 42, 43, 52, and 53 were rejected in the Office Action under 35 USC §103(a) as being unpatentable over Gudjonsson in view of Tang and further in view of Gidwani, U.S. patent 6,640,239 (Gidwani). Applicant respectfully traverses the rejection of these claims. As previously asserted, neither Gudjonsson nor Tang disclose, teach or suggest, alone or in combination, a method of establishing a video conference in response to a request for same by an instant messaging server, nor any suggestion for how the teachings of the two references may be combined to obtain such a feature. Gidwani discloses the configuration of a network switching architecture. It discloses no details of instant messaging or video conferencing. It does not even allude to the difficulties of launching one type of communication service (i.e., video conferencing) using messaging from another type of communication service (i.e., instant messaging). Therefore, Gidwani fails to overcome the aforementioned shortfalls of Gudjonsson and Tang in terms of establishing a *prima facie* case of obviousness of claims 1 and 28, as well as the claims depending from claims 1 and 28. As claims 7, 8, 15, 16, 25, and 26 depend directly or indirectly from claim 1 and claims 34, 35, 42, 43, 52, and 53 depend directly or indirectly from claim 28, they contain all of the limitations of claims 1 and 28, respectively. Thus, those claims are patentably distinct from the cited references for at least the reasons enumerated above with regard to claims 1 and 28. Accordingly, applicant respectfully traverses the rejections of claims 7, 8, 15, 16, 25, 26, 34, 35, 42, 43, 52, and 53, and requests their reconsideration and allowance.

CONCLUSION

In view of the foregoing, applicant believes all claims pending in this application now distinguish over the cited art and are in condition for allowance. The issuance of a formal Notice of Allowance of this application at the earliest possible date is respectfully requested.

If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,



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